REMARKS/ARGUMENTS

Continued and favorable examination are respectfully requested.

Support for the Amendments:

Claims 14-18, 20, 21, 23, 24, and 26-31 are pending. Claims 14, 24, and 27 are amended. Support for the amended claims can be found, for example, at least at page 6, lines 1-6, and in the abstract. The claims are amended solely in an effort to expedite prosecution, without acquiescing in the propriety of the rejection and with reservation to later prosecute the subject matter of the claims as set forth in the claim language prior to amendment.

Rejection of the Claims Under 35 U.S.C. § 102

In the Office Action, at page 2, the Examiner rejected claims 27, 29, and 31 under 35 U.S.C. § 102(e) as allegedly being anticipated by Adourian et al. Applicants respectfully traverse this rejection.

Applicants have amended independent claim 27 to recite transferring samples in "an automatic transfer device" and "wherein a one-to-one correspondence between a work surface coordinate and a loading well is not required." Adourian et al. fails to teach a method for handling a plurality of samples that uses an "automatic transfer device." Additionally, as noted in the rejection that follows, Adourian et al. fails to address "transferring the samples with a device programmed such that a one-to-one correspondence between a work surface coordinate and a loading well is not required." Therefore, claim 27 and those rejected claims dependent

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thereon, fail to be anticipated by Adourian et al. This rejection is improper and should be withdrawn.

Rejection of the Claims Under 35 U.S.C. § 103

At page 4 of the Office Action, the Examiner rejected claims 14-17, 20, 21, 23, 24, 26, 28, and 30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adourian et al. in view of Lewis. Applicants respectfully traverse this rejection.

Applicants have amended independent claims 14, 24 and 27 to recite transferring samples in "an automatic transfer device." Adourian et al. fails to suggest a method for handling samples that uses "an automatic transfer device" to transfer at least two of the samples from their respective work surface to respective loading wells in a capillary electrophoresis apparatus. Therefore, claims 14, 24 and 27, as well as those claims dependent thereon fail to be suggested by Adourian et al. At best, as noted by the Examiner, Lewis discloses no more than the use of Finnpipettes. Lewis fails, however, to disclose or suggest a Finnpippetor as part of a multi-channel capillary electrophoresis apparatus. Therefore, nothing in Lewis remedies the deficits of Adourian et al., and Adourian et al., even in combination with Lewis, fails to render obvious the amended claims.

Applicants hereby amend the claims, solely in an effort to expedite prosecution, without acquiescing in the propriety of the rejection. Even before the amendment, however, Adourian et al. in combination with Lewis failed to render obvious the claimed invention.

The Examiner had set forth specifics of the rejection on pages 4-7. Most importantly,

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however, at page 7 of the Office Action, the Examiner acknowledges that:

> Adourian et al does not explicitly address transferring the samples with a device programmed such that one-to-one correspondence between a work surface coordinate and a loading well is not required (Claims 14, 24, and 28), nor do they explicitly address decoupling the spatial arrangement of the work surface coordinates/sample wells from the capillary inlets. (Claims 23, 26, and 30).

Thus, even before the claims were amended, the Examiner admits that Adourian et al. fails to disclose or suggest claims 14, 24 and 28.

At the bottom of page 7, the Examiner further admits that Adourian et al. recited "no requirement" that there be a "one-to-one correspondence" between work surface coordinates and loading wells." The Examiner then proceeds to discuss a pipetter with eight tips on fixed centers for sample transfer and argues that:

> It would have been obvious to one having ordinary skill in the art to use arrays of more than eight loading wells . . . in a row... given the benefits in time and labor saved through parallel analysis. In such an array, there would obviously be no requirement for one-to-one correspondence between work surface coordinates and loading wells.

The Examiner also recites "Added motivation to use the multiPROBE system lies in its variable tip spacing, which one having ordinary skill in the art would have recognized as providing highly desirable flexibility in operation." Merely because a system discussed in the prior art may have certain characteristics, this cannot be said to provide a motivation to combine Lewis with Adourian et al.

It should be noted that while the MultiPROBE is described as being automated and a liquid handling system, it is not part of a capillary electrophoresis system, as required by the

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language of the claims. Claim 14, for example, recites "a method for handling a plurality of samples ***in a multi-channel capillary electrophoresis apparatus***." Merely, because a component such as a pipettor may exist independently, this cannot render obvious, the claimed invention. Nowhere, is there any suggestion in Lewis that samples handled in the Finn apparatus are samples in a multi channel capillary electrophoresis apparatus. Further, there is nothing in Lewis that would motivate one of ordinary skill in the art to combine Lewis with Adourian et al. to use the apparatus in a capillary electrophoresis apparatus.

Additionally, at page 12, the Examiner notes that Applicants did not explicitly address the Adourian et al. disclosure at page 6, line 20 to page 7, line 20. In this regard, Applicants note that the disclosure states that it "analyzes the samples and records the analysis in an automated, rapid, and highly parallel manner." (page 6, lines 24-25). This still fails to render the claimed invention obvious because the amended claim language refers to transferring samples simultaneously in an "automatic transfer device." This is not referred to at the cited paragraph in Adourian et al. and is not the same as automatically recording an analysis.

The test for combining cited art is not that one had a motivation to use a certain system within the art, for example, a Finnpipettor, but rather that there be a motivation in the art to combine the two particular references applied by the Examiner. Merely because a certain aspect of the claimed invention may or may not be present in the art, there is no basis for using that aspect of the claimed invention unless there is a motivation or suggestion to combine the references. Such a motivation or suggestion has not been shown by the Examiner.

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In the recent Federal Circuit decision *In re Scott E. Johnston,* 05-1321, *Page 5 (Fed. Cir., Jan. 30, 2006) (Fed. Cir. BBS), the court reiterated the following:

> Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.") . . . Interconnect Planning Corp. v. Feil., 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.") . . . See, In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (obviousness requires proof "that the skilled artisan...would select the elements from the cited prior art references for combination in the manner claimed.")

The Examiner has failed to apply the above legal standards because:

1. No motivation has been provided ***from the prior art*** to support the selection of teachings from separate references for combination.

2. No motivation or suggestion has been provided ***from the prior art*** to combine the teachings in a way that would produce the claimed invention.

3. No reason ***other than hindsight*** gleaned from Applicants' specification has been provided for the combination.

4. No proof has been provided that a skilled artisan would select the elements from the cited art for combination in the manner claimed.

Based on all of the above, this rejection is overcome and should be withdrawn.

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On page 9 of the Office Action, the Examiner rejected claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adourian et al. and Lewis as applied to claim 14 above, and further in view of either Ginsberg et al. or Monthony et al. Applicants respectfully traverse this rejection.

Even assuming *arguendo* that Ginsberg et al. or Monthony et al. discloses or suggests limitations in claim 18 missing from Adourian et al., the combination still fails to render the invention obvious in view of the cited art. The combination cannot succeed in rendering obvious the subject matter of claim 18 because, as set forth above, Adourian et al. in combination with Lewis as applied to claim 14, fails to render the invention of claim 14 obvious. If the invention of claim 14 is not rendered obvious in view of Adourian et al. and Lewis, the additional combination of Ginsberg et al. or Monthony et al. cannot render obvious claim 18 which is dependent on claim 14. Therefore, this rejection is overcome and should be withdrawn.

At page 10 of the Office Action, the Examiner rejected claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adourian et al. and Lewis as applied to claim 14, and further in view of Truchaud et al. Applicants respectfully traverse this rejection.

The rejection of claim 18 over the cited art must fail because, as clearly set forth above, Adourian et al. and Lewis fail to render obvious amended claim 14. The addition of further references to the combination will fail to render dependent claim 18 obvious because the initial combination fails to render obvious all of the aspects of independent claim 14, from which claim 18 depends. Therefore, this rejection is overcome and should be withdrawn.

At page 11 of the Office Action, the Examiner rejected claim 18 under 35 U.S.C. § 103(a)

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as allegedly being unpatentable over Adourian et al. and Lewis as applied to claim 14 above and further in view of Hansen et al. Applicants respectfully traverse this rejection for all the reasons set forth immediately above in response to the previous rejection. The additionally cited art still fails to render claim 18 obvious because claim 14, upon which claim 18 depends, has not been rendered obvious. Therefore, this rejection is overcome and should be withdrawn.

For all the reasons set forth above, the rejections are overcome and Applicants respectfully submit that the claims are in condition for allowance.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration of the present application and a timely allowance of the pending claims.

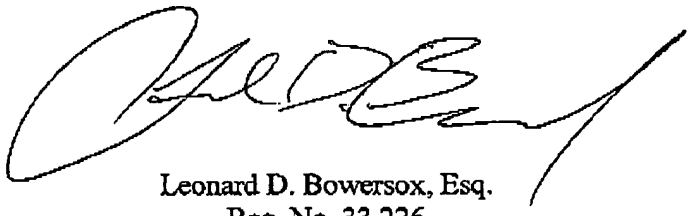
Should the Examiner deem that any further action by Applicants or Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

If there are any fee(s) due in connection with the filing of this response, please charge the

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fee(s) to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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